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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/743,300	01/08/2001	Michael Becker	3535.010	7235

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EXAMINER

PIERCE, JEREMY R

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 09/12/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/743,300

Applicant(s)

BECKER ET AL.

Examiner

Jeremy R. Pierce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 8-13 and 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 14-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-7 and 14-17, drawn to a mineral wool composite.

Group II, claim(s) 8-12, and 18-20, drawn to a process of making a mineral wool composite.

Group III, claim 13, drawn to a coating mass.

2. The inventions listed as Groups I, II, and III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The special technical feature shared among the groups is the coating in claim 13. Claim 13 is obvious over WO 95/13252. Accordingly, the special technical feature linking the three inventions, the siliceous coating, does not provide a contribution over the prior art, and no single general inventive concept exists. Therefore, restriction is appropriate.

3. During a telephone conversation with Evelyn Defillo on September 3, 2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-7 and 14-17. Affirmation of this election must be made by applicant in replying

to this Office action. Claims 8-13 and 18-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5, 6, 14, and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites, "The mineral wood product according to claim 4, wherein said layer (2) further contains". Although the number (2) would indicate that the layer being referred to is the coating, the Examiner believes this language to be confusing on the grounds that other layers in the composite exist. The Examiner would suggest changing "layer" to "coating", similar to the claim languages of claims 4 and 6.

Claim 6 recites "said coating (2) additionally contains foam layer forming agents". Do these agents form the coating into a foam, or do they form an additional layer of foam that is somehow attached to the coating?

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 6, 7, and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vane (U.S. Patent No. 4,808,465) in view of Kummermehr (EP 728,124).

Vane discloses a composite material useful in thermal and/or acoustic insulation (column 1, lines 4-11). The mineral wool product is lead wool, which comprises one layer of the composite (column 1, lines 35-38). Fibrous mats of glass fibers or mineral wool sandwich the layer of lead wool (column 1, lines 39-51). Vane does not teach applying the siliceous foam containing at least one organic plastic disclosed by the Applicant. However, Applicant discloses that Kummermehr teaches the coating material used in the present invention, including the siliceous foam containing organic plastic (page 5, lines 1-23). The English translation of the abstract discloses that such foam exposes the open surfaces of the rock wool product, which would allow better absorption of sound waves. It would have been obvious to one having ordinary skill in the art to incorporate siliceous foam into the composite material of Kummermehr rather than using the Polyvoltac foam, in order to increase the sound absorption properties of the composite material. With regard to claim 2, Applicant discloses that Kummermehr already teaches the coating. With regard to claim 3, Vane discloses the fibrous mat can be formed from glass fibers or mineral wool. It would have been obvious to one having ordinary skill in the art to use glass wool, since glass wool is a common type of mineral wool, and Vane already discloses the use of glass fibers. With regard to claims 7, 16, and 17, Vane does not disclose the basis weight of the fibrous mat. It would have been obvious to one having ordinary skill in the art to make the fibrous mat with the claimed

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basis weight ranges, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. With regard to claim 15, there is no disclosure as to the preferred foaming agent used to foam the coating. It would have been obvious to one having ordinary skill in the art to use expanded graphite or pentaerythritol as the foaming agent in the silica resin, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

8. Claims 4, 5, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vane in view of Kummermehr as applied to claim 1 above, and further in view of Berbeco (U.S. Patent No. 4,301,040).

Vane and Kummermehr do not teach adding electrically conductive or magnetically active material to the coating. Berbeco discloses resinous foam layers can be made anti-static by incorporating graphite fibers (column 3, lines 28-50). It would have been obvious to one having ordinary skill in the art to add graphite fibers to the siliceous resin of Kummermehr in order to provide an acoustic insulation material that is static-resistant.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (703)

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605-4243. The examiner can normally be reached on Monday-Thursday 7-4:30 and alternate Fridays 7-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Jeremy R. Pierce
Examiner
Art Unit 1771

September 9, 2002



ELIZABETH M. COLE
PRIMARY EXAMINER